

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD A. LEWINE

Appeal No. 1997-1354
Application No. 08/432,610

ON BRIEF

Before KRASS, FLEMING, and HECKER, Administrative Patent Judges.

HECKER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 12, all claims pending in this application.

The invention relates to performing retail client/server transactions on the internet using the HyperText Transfer Protocol (HTTP). According to the Appellant, it is not possible

to carry on a dialog using the HTTP protocol because there is no history of previous transactions. Most people attempting to sell products using the World-Wide Web put up with the limitations of HTTP and require the user to enter a name, address, and credit card number for every item bought. The current invention extends the capabilities of the HTTP protocol to allow a user to identify himself and create a session, he can then conduct transactions during that session without identifying himself again.

Representative independent claims 1 is reproduced as follows:

1. A method for ordering goods or services from a store on the world wide web where said store is implemented using a server computer having:
 - (a) the capability of being accessed by a plurality of users each said user having a browser;
 - (b) a plurality of user profile records, one or more unprotected pages, and one or more protected pages;
 - (c) a unique first username associated with each profile record;
 - (d) a first password associated with each profile record; and
 - (e) the capability of at least one of said users accessing at least one of said unprotected pages without supplying a user-name or password;said method of associating one of said users with one of said profile records comprising:
 - (i) allowing said user to attempt to access one of said protected pages using the http GET method;

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(ii) returning an ACCESS DENIED code in response to said attempt;
(iii) said ACCESS DENIED code causing said user's browser to ask said user for a second username and a second password and to transmit said second username and said second password to said server computer in the http authorization header; and
(iv) locating one of said user profile records such that said second username and said second password match the first username and first password associated with said stored user profile.

The references relied on by the Examiner are as follows:

Dworkin	4,992,940	Feb. 12, 1991
Lawlor et al. (Lawlor)	5,220,501	Jun. 15, 1993
King, Jr. et al. (King, Jr.)	5,319,542	Jun. 7, 1994

Relevant protocols, Webmaster@w3.org, (Date unknown, but at least March 1993)

Claims 1 through 12 stand rejected under 35 U.S.C. § 112, second paragraph.¹

Claims 1 through 12 stand further rejected under 35 U.S.C.

¹ In paragraph 17 of the final rejection, claims 1-7 are recited as subject to this rejection. However, paragraph 17 continues by referring to claims 1-12 as does the Examiner's Answer.

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§ 103 as being unpatentable over Dworkin in view of King,
Lawlor and Relevant Protocols.

Rather than repeat the arguments of Appellant or the
Examiner, we make reference to the brief and the answer for
the details thereof.

OPINION

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 12 under 35 U.S.C. § 112, second paragraph (as expressed by the Examiner), nor under 35 U.S.C. § 103.

The Examiner maintains that the claims are indefinite for attempting to claim an apparatus in combination with a method (answer-page 3), that hybrid claims are not permitted, and a claim must include only one of the four statutory classes of invention (final rejection-page 2). We do not agree with the Examiner. A claim is not limited to only one statutory class of invention as long as one of ordinary skill in the art can understand that which Appellant is claiming. Also, Appellant has amended all claims to be directed to a method, thus we find no combination of statutory classes in the claimed invention. We note however, although claim 1 is a method claim, it appears to include a method within a method, i.e., a method of associating user profile records within a method for ordering goods or services. This too, is not fatal to the patentability of a claim if one can understand the scope of claimed invention. Thus, we will not sustain the Examiner's

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35 U.S.C. § 112, second paragraph, rejection since it is unsupported by the Examiner's reasons.

On the outset, we must initially ascertain the scope of Appellant's claims 1 through 12. Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. ***In re Johnson***, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977). As discussed ***infra*** in the new ground of rejection of claims 1 through 12, we conclude that the claims fail to set forth the invention with a reasonable degree of precision and particularity as required under 35 U.S.C. § 112, second paragraph. As a result, we cannot rule on whether the claims are unpatentable under 35 U.S.C. § 103 over the references of record. A prior art rejection cannot be sustained if what is required is speculation and assumptions as to the scope of the claims. ***In***

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re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

Thus, we will not sustain the rejection of claims 1 through 12
under 35 U.S.C. § 103.

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NEW GROUND OF REJECTION

Pursuant to the provisions of 37 CFR § 1.196(b), we hereby enter the following new rejection.

Claims 1 through 12 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

Appellant's claim 1, section (iii) recites that the user's browser is **caused** to ask for a **second username** and a **second password**, and to **transmit** these in the **http** authorization **header**. First, we cannot find any explanation in the claims or specification as to how this is **caused**. Do **all** browsers **automatically** ask for a username and password when access is denied? Second, what is the **second** username and password, is it the same (or can it be the same) or different than the **first** username and password? We find no explanation in the specification of a **second** username and **second** password. Third, does the **second** username and password **automatically** get **transmitted** in the **http header**, does the **first** username and

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password previously in the hppt header **automatically** get **replaced**, and if so, how did the **first** username and password get in the hppt **header** to begin with?

With respect to claim 1 section (iv), how is the **match** performed? We find no explanation in the specification. Are the **first** username and password the **same** as the **second** username and password, thus the **match**? If not the same, how is the **match** accomplished?

With respect to claim 8 section (i), is the hppt GET method inherent in the hppt protocol? We see nothing in the specification with respect to the hppt GET method, although it is recited in Appendix A. Looking at claim 8 section (iii), we find the same ambiguities with **causing**, **second** username and hppt **header** as we did with those recited in claim 1.

Similarly, we do not understand what is being claimed with the **match** of claim 8 section (iv). We note that all the indefiniteness associated with independent claims 1 and 8 **supra** necessarily extends to their dependent claims.

As a minor issue, we find antecedent problems with "**said** method of associating" in claim 1, and "**said** second plurality

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of users" in claim 9 when "**a** second user" was recited in claim 8.

We also note that due to the difficulty in determining exactly what is being claimed, it cannot be determined if sufficient support exists in the specification.

Thus, we find claims 1 through 12 fail to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention.

DECISION

The Examiner's decision rejecting claims 1 through 12 under 35 U.S.C. § 112, second paragraph, is unconvincing as presented and is reversed. The Examiner's decision rejecting claims 1 through 12 under 35 U.S.C. § 103 is reversed because we are not able to apply the references of record to the indefinitely claimed invention. A new ground of rejection of claims 1 through 12 under 35 U.S.C. § 112, second paragraph, is entered under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final

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rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203
Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not
be considered final for purposes of judicial review."

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37 CFR § 1.196(b) also provides that the appellant,
WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise
one of the following two options with respect to the new
ground of rejection to avoid termination of proceedings
(§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so
rejected or a showing of facts relating to the claims so
rejected, or both, and have the matter reconsidered by
the examiner, in which event the application will be
remanded to the examiner. . . .

(2) Request that the application be reheard under
§ 1.197(b) by the Board of Patent Appeals and
Interferences upon the same record. . . .

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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REVERSED

Prepared: June 22, 2001